UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,580	11/01/2001	Yoon Kean Wong	82594858	2720

22879   7590   01/25/2012
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ART UNIT	PAPER NUMBER
3621	

NOTIFICATION DATE	DELIVERY MODE
01/25/2012	ELECTRONIC

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/001,580
Filing Date: November 01, 2001
Appellants: WONG ET AL.

John F. Kacvinsky (40,040)
For Appellants

EXAMINER'S ANSWER

This is in response to the appeal brief filed 20 October 2011 ("2011 Brief") appealing from the

Office Action mailed 20 April 2011 ("2011 Final Office Action").

(1) Real Party in Interest

The Examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the 2011 Brief.

(2) Related Appeals and Interferences

The Examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 30-34, 36, 37, 39-42, 44-46, 48-52, 54, and 56-59 are pending.

Claims 30-34, 36, 37, 39-42, 44-46, 48-52, 54, and 56-59 are rejected.

(4) Status of Amendments After Final

The Examiner has no comment on the Appellants' statement of the status of amendments after final rejection contained in the 2011 Brief.

(5) Summary of Claimed Subject Matter

The Examiner has no comment on the summary of claimed subject matter contained in the 2011 Brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The Examiner has no comment on the Appellants' statement of the grounds of rejection

to be reviewed on appeal. Every ground of rejection set forth in the 2011 Final Office Action is

being maintained by the Examiner.

(7) Claims Appendix

The Examiner has no comment on the copy of the appealed claims contained in the

Appendix to the Appellants' 2011 Brief.

(8) Evidence Relied Upon

6,901,261 B2	Banatre et al.	05-2005
5,528,248 A	Steiner et al.	06-1996
6,324,522 B2	Peterson et al.	11-2001
6,269,342 B1	Brick et al.	07-2001
6,012,834 A	Dueck et al.	01-2000
EP 0 568 824 A2	Vendetti et al.	11-1993

(9) Grounds of Rejection

The following grounds of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC §103

1.   Claims 30-32, 36, 37, 39, 40, 45, 46, 48-50, 52, 54, and 56-59 are rejected under 35

U.S.C. §103(a) as being unpatentable over Banatre et al. (U.S. 6,901,261 B2) ("Banatre"), in

view of Steiner et al. (U.S. 5,528,248 A) ("Steiner"), and in view of Peterson et al. (U.S.

6,324,522 B2) ("Peterson").

Regarding Claims 30, 39, and 48

2.   Banatre discloses:

   a.   a handheld computer ("portable sets," *e.g.*, "personal digital assistant" – see at

least c. 2, ll. 13-15 and c. 5, ll. 27-28; also referred to as "portable set Ui") comprising (a) a

location circuit configured to provide location data ("communication **4**" discussed in at least c. 5,

ll. 55-59 and shown in fig. 1 as containing at least a "Pid" and as sent from the "Ui" (*i.e.*,

"portable set Ui") to the Si via the Bai; see also c. 6, ll. 17-19 describing the Pid; also a hardware

component equivalent to the "location circuit" is *necessarily present* in the "portable set" since

the portable set provides the "communication **4**" (*i.e.*, the claimed "location data")) based at least

in part on the location of the handheld computer (again see at least c. 6, ll. 17-19 describing the

Pid as indicating the position or location of user and Ui) and (b) a wireless transceiver (see

communication interface discussed in at least c. 5, ll. 27-37) configured to provide wireless

communication of the location data and a user identifier (see again "communication **4**" discussed

in at least c. 5, ll. 55-59 and shown in fig. 1 as containing a "Uid" (*i.e.*, user identifier); see also

c. 5, ll. 21-22 describing "Uid"); and

        b.   a data processor configured to receive the location data and the personal identifier (see at least the Bai of fig. 1) and to send a targeted promotion for selling a product to a person associated with the user identifier based at least in part on the location data (see at least c. 7, ll. 15-30 discussing a user targeted product promotion; see also pricing characteristic of a context-sensitive service discussed in c. 2, ll. 5-8; see also c. 1, ll. 10-18).

3.   Banatre does not directly disclose:

        c.   wherein the location circuit is configured to provide the location data using at least one of a signal from a global positioning system and radio frequency (RF) triangulation, and (b) a wireless transceiver; and

        d.   a data processor configured to set a price for selling the product, and to adjust the price lower for selling the product for a person associated with the user identifier.

4.   Steiner teaches a location circuit ("GPS Smart Antenna **20**") configured to provide location data using a signal from a global positioning system (see at least c. 8, l. 49 – c. 9, l. 4; and fig. 1).

5.   Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the handheld device of Banatre to have a location circuit as taught by Steiner. One would have been motivated to do so because the location circuit of Steiner also provides "rate of change of location of the [circuit]" and "heading of the [circuit]." Steiner at 8:60-62. This is an advantage over the location device of Banatre. Steiner's device not only provides the location data, it also provides data about the speed and direction of the device. Implementing such a device would be a beneficial modification to the system of Banatre because it would allow vendors to predict a customer's next location.

6.   For example, in Banatre, one use of the location device is to determine whether a

customer is in a particular department of a department store. Banatre at 7:16-29. Depending on

the department the customer is located in, a promotion is sent to the device regarding a product

in the respective department; and, moreover, the promotion cannot be sent until the system

determines which department the user is located in. However, if a user is moving quickly and is

simply passing through a department, Banatre's promotion may not reach the customer until they

have gone onto the next department. This would be ineffective in attracting a sale to that

particular department because the user may not feel like backtracking to review the promoted

product. On the other hand, if Banatre's device was able to determine the speed and direction of

the user (like Steiner's device), then Banatre's device would be able to provide information

allowing the department store owner to predict the next department the user will be entering and

send a promotion based on the next predicted department *before* the user gets to the department.

This would be more effective because the customer would be alerted to promotions *prior to*

arriving at the department, and thus more likely to stop and review the promoted product.

7.   Peterson teaches a data processor configured to receive a personal identifier, to set a price

for selling a product, and to adjust the price lower for selling the product for a person associated

with the user identifier (see at least c. 24, ll. 9-20).

8.   Therefore, it would have been obvious to one of ordinary skill in the art, at the time the

invention was made, to modify the system of Banatre, which delivers a context-sensitive

promotion of a product based on a user ID and a position ID of the user, to include the

functionality of Peterson's system that sets prices and adjusts the prices based on specific user's

ID. One would have been motivated to do so because this would allow the vendors of Banatre to

include user specific pricing in their targeted promotions. See Peterson at c. 24, ll. 9-20

("enables [a] vendor to quote different prices to different customers.").

Regarding Claims 31, 32, 36, 37, 40, 45, 46, 49, 50, 52, 54, and 56-59

9.   The combination of Banatre and Peterson meet the limitations of claims 30, 39, and 48,

as shown above, and further disclose the limitations of:

        e.   At least claim 31: A system for pricing a product as in claim 30, wherein the data

processor is remote from the handheld computer (Banatre: fig. 1);

        f.   At least claim 32: A system for pricing a product as in claim 31, wherein the data

processor is configured to receive the location data from the location circuit wirelessly through a

cellular network (Banatre: c. 5, ll. 55-59);

        g.   At least claim 36: A system for pricing a product as in claim 30, wherein the data

processor is configured to dynamically adjust the price for the product based on the location of

the handheld computer (promotion of Banatre is based on location of the Ui; moreover, the

promotion can be a price adjustment as in Peterson; therefore, the combination meets a price

adjustment based on location – see citations above with respect to claim 30);

        h.   At least claim 37: A system for pricing a product as in claim 30, wherein the

location data further comprises a distance between the location of the handheld computer and a

provider of the product (Banatre: description of Pi and "perimeter");

        i.   At least claim 54: The system of Claim 30, wherein the handheld computer

comprises a cellular telephone (Banatre: c. 2, ll. 12-14); and

j.   At least claim 58: The system of Claim 30, wherein the data processor is further

configured to receive user information and to set the price for the product based on the user

information (see at least Banatre at c. 7, ll. 15-30 and Peterson at c. 24, ll. 9-20).

10.   Claims 33, 41, 44, and 51 are rejected under 35 U.S.C. §103(a) as being unpatentable

over Banatre et al. (U.S. 6,901,261 B2) ("Banatre"), in view of Steiner et al. (U.S. 5,528,248 A)

("Steiner"), in view of Peterson et al. (U.S. 6,324,522 B2) ("Peterson"), and in further view of

Brick et al. (U.S. 6,269,342 B1) ("Brick").

Regarding Claims 33, 41, 44, and 51

11.   The combination of Banatre, Steiner, and Peterson meet the limitations of claims 30, 39,

and 48, as shown above. The combination further discloses adjusting a price of a product based

on a change of the location of the handheld computer (Banatre discloses the PDA enters

perimeter and user receives promotion for the product, combined with Peterson's price

adjustment as an integral part of the promotion).

12.   The combination does not directly disclose wherein the data processor is further

configured to price the product based on a date or a time of day.

13.   Brick teaches a data processor configured to price a product based on a date or a time of

day (c. 11, ll. 38-53 & c. 15, l. 60 – c. 16, l. 6).

14.   Therefore, it would have been obvious to one of ordinary skill in the art, at the time the

invention was made, to modify Banatre and Peterson to price products based on a date or a time

of day, as taught by Brick, in order to vary pricing according to competitors (Brick: c. 15, l. 60 –

c. 16, l. 6).

15.   Claims 34 and 42 are rejected under 35 U.S.C. §103(a) as being unpatentable over

Banatre et al. (U.S. 6,901,261 B2) ("Banatre"), in view of Steiner et al. (U.S. 5,528,248 A)

("Steiner"), in view of Peterson et al. (U.S. 6,324,522 B2) ("Peterson"), and in further view of

Dueck et al. (U.S. 6,012,834 A) ("Dueck").

Regarding Claims 34 and 42

16.   The combination of Banatre, Steiner, and Peterson meet the limitations of claims 30, 39,

and 48, as shown above. The combination does not directly disclose wherein the data processor

is further configured to price the product based on an environmental condition, including a

weather condition.

17.   Dueck teaches a data processor configured to price products based on an environmental

condition, including a weather condition (c. 2, ll. 6-13).

18.   Therefore, it would have been obvious to one of ordinary skill in the art, at the time the

invention was made, to modify Banatre and Peterson to price products based on weather, as

taught by Dueck, in order to price products for current demand (Dueck: c. 1, ll. 52-58).

19.   Claims 30-33, 36, 37, 39-41, 44-46, 48-52, 54, and 56-59 are *alternatively* rejected under

35 U.S.C. §103(a) as being unpatentable over Vendetti et al. (EP 0 568 824 A2) ("Vendetti"), in

view of Steiner et al. (U.S. 5,528,248 A) ("Steiner").

Regarding Claims 30-33, 36, 37, 39-41, 44-46, 48-52, 54, and 56-59

20.　　Vendetti discloses:

　　　k.　　a handheld computer ("mobile unit 62") comprising (a) a location circuit configured to provide location data based at least in part on the location of the handheld computer, and (b) a wireless transceiver configured to provide wireless communication of the location data and a user identifier; and a data processor configured to receive the location data and the personal identifier, to set a price for selling a product, and to adjust the price lower for selling the product to a person associated with the user identifier based at least in part on the location data (see at least abstract; c. 5, ll. 20-44; c. 6, ll. 20-40; c. 7, ll. 1-30; c. 8, ll. 31-50).

21.　　Vendetti does not directly disclose wherein the location circuit is configured to provide the location data using at least one of a signal from a global positioning system and radio frequency (RF) triangulation.

22.　　Steiner teaches a location circuit ("GPS Smart Antenna **20**") configured to provide location data using a signal from a global positioning system (see at least c. 8, l. 49 – c. 9, l. 4; and fig. 1).

23.　　Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the handheld device of Vendetti to have a location circuit as taught by Steiner. One would have been motivated to do so because the location circuit of Steiner also provides "rate of change of location of the [circuit]" and "heading of the [circuit]." Steiner at 8:60-62. This is an advantage over the location device of Vendetti. Steiner's device not only provides the location data, it also provides data about the speed and direction of the

device. Implementing such a device would be a beneficial modification to the system of

Vendetti because it would allow a customer to be alerted to a rising price if they were headed for

a more expensive coverage zone.

24.   Claims 34 and 42 are *alternatively* rejected under 35 U.S.C. §103(a) as being

unpatentable over Vendetti et al. (EP 0 568 824 A2) ("Vendetti"), in view of Steiner et al. (U.S.

5,528,248 A) ("Steiner"), and in further view of Dueck et al. (U.S. 6,012,834 A) ("Dueck").

Regarding Claims 34 and 42

25.   The combination of Vendetti and Steiner meet the limitations of claims 30, 39, and 48, as

shown above. The combination does not directly disclose wherein the data processor is further

configured to price the product based on an environmental condition, including a weather

condition.

26.   Dueck teaches a data processor configured to price products based on an environmental

condition, including a weather condition (c. 2, ll. 6-13).

27.   Therefore, it would have been obvious to one of ordinary skill in the art, at the time the

invention was made, to modify Vendetti to price products based on weather, as taught by Dueck,

in order to price products based on current demand (Dueck: c. 1, ll. 52-58).

       (10) Response to Argument

28.   Arguments which Appellants could have made but chose not to make in the 2011 Brief

have not been considered by the Examiner and are deemed to be waived. See 37 C.F.R. §

41.37(c)(1)(vii). Moreover, Appellants are given actual notice that any additional arguments that

are raised for the first time in the Reply Brief are waived. See *Optivus Tech., Inc. v. Ion Beam*

Applications S.A., 469 F.3d 978, 989, 80 USPQ2d 1839, 1847-48 (Fed. Cir. 2006) ("[A]n issue

not raised by an Appellant in its opening brief … is waived." (citation omitted) (internal

quotation marks omitted)); *Ex parte Borden IV*, No. 2008-004312, slip op. (BPAI January 7,

2010) (informative)[1]; and *Ex parte Scholl*, No. 2007-3653, slip op. at 18-19 & n.13 (BPAI Mar.

13, 2008) (informative)[2].

29.   With respect to independent claims 30, 39, and 48, Appellants' arguments against the

§103 rejections do not address each independent claim separately.

30.   Because Appellants do not present separate arguments for each of independent claims 30,

39, and 48, the Examiner will address claim 30 as an exemplary claim for prior art purposes.

31.   Because claims 39 and 48 are not argued separately, these claims stand or fall with the

patentability of claim 30.

32.   With respect to dependent claims 31-34, 36, 37, 40-42, 44-46, 49-52, 54, and 56-59

Appellants' arguments against the §103 rejections do not address each dependent claim

separately from independent claim 30.

33.   Because claims 31-34, 36, 37, 40-42, 44-46, 49-52, 54, and 56-59 are not argued

separately, these claims stand or fall with the patentability of claim 30.

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[1] Available at http://www.uspto.gov/ip/boards/bpai/decisions/inform/fd08004312.pdf
[2] Available at http://www.uspto.gov/web/offices/dcom/bpai/its/fd073653.pdf

A. 35 U.S.C. §103 Rejection of Claims 30-34, 36, 37, 39-42, 44-46, 48-52, 54, and 56-59

(Banatre in view of Steiner and in view of Peterson)

34.   Appellants argue:

> For example, claim 30 recites the following language, in relevant part:
>
>> a data processor configured to receive the location data and the personal
>> identifier, to set a price for selling the product, and to adjust the price
>> lower for selling the product to a person associated with the user identifier
>> based at least in part on the location data.
>
> As correctly noted in the Office Action, the above-recited language is not
> disclosed by Banatre. See Office Action at page 4, paragraph 7.

2011 Brief, page 10, lines 10-18.

35.   This argument cannot be persuasive because it is <u>factually incorrect</u>.   Appellants allege

that the Office Action (at page 4, paragraph 7) correctly notes that the claimed "a data processor

configured to receive the location data and the personal identifier, to set a price for selling the

product, and to adjust the price lower for selling the product to a person associated with the user

identifier based at least in part on the location data" is not disclosed by Banatre. This statement

is <u>factually incorrect</u>. In fact, at page 4, paragraph 7 of the 2011 Final Office Action, the

Examiner stated "Banatre does not directly disclose: … a data processor configured to set a price

for selling the product, and to adjust the price lower for selling the product for a person

associated with the user identifier." This statement is self-evidently not equivalent to what

Appellants allege above. For this reason alone, Appellants' argument cannot be persuasive.

36.   Additionally, Appellants argue "According to the Office Action, the above-recited language is disclosed by Peterson at column 24, lines 9-20. See Office Action page 5, paragraph 11. Applicant respectfully disagrees."

37.   Again, this argument cannot be persuasive because it is <u>factually incorrect</u>. Appellants allege that the Office Action (at page 5, paragraph 11) cites Peterson as disclosing the claimed "a data processor configured to receive the location data and the personal identifier, to set a price for selling the product, and to adjust the price lower for selling the product to a person associated with the user identifier based at least in part on the location data." This statement is <u>factually incorrect</u>. In fact, at page 5, paragraph 11 of the 2011 Final Office Action, the Examiner stated "Peterson teaches a data processor configured to receive a personal identifier, to set a price for selling a product, and to adjust the price lower for selling the product for a person associated with the user identifier (see at least c. 24, 11.9-20)." This statement is self-evidently not equivalent to what Appellants allege above. For this reason alone, Appellants' argument cannot be persuasive.

38.   Additionally, Appellants argue "Peterson fails to disclose the above-recited language of the claimed subject matter." 2011 Brief, page 10, lines 22-23.

39.   This argument is not persuasive because Appellants' are attacking the references individually where the rejection is based on the combination of Banatre and Peterson. In response to Appellants' arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on

combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

40.　　In other words, the Examiner never relied on Peterson *alone* to disclose "a data processor configured to receive the location data and the personal identifier, to set a price for selling the product, and to adjust the price lower for selling the product to a person associated with the user identifier based at least in part on the location data." The Examiner used both Banatre *and* Peterson to show that the claimed "a data processor configured to receive the location data and the personal identifier, to set a price for selling the product, and to adjust the price lower for selling the product to a person associated with the user identifier based at least in part on the location data" is an obvious feature to one of ordinary skill in the art. See 2011 Final Office Action, page 3, lines 16-20, page 4, lines 1 and 5-6, and page 5, lines 10-19. Because Appellants are arguing against Peterson *alone* for the disputed claim elements above, and because the Examiner used *both* Banatre *and* Peterson to show the disputed claim elements above, Appellants' argument cannot be persuasive.

B. 35 U.S.C. §103 Rejection of Claims 30-34, 36, 37, 39-42, 44-46, 48-52, 54, and 56-59 (Vendetti in view of Steiner)

41.　　Appellants argue:

> Vendetti merely discloses a rate table associating rates with zones. There appears to be no price adjustment within the rate tables. For example, the prices within each zone remain constant and are not adjusted based upon the location of a mobile device. Claim 30 recites, "adjust the price lower for selling the product to a person associated with the user identifier based at least in part on the location

　　　　　data." The system disclosed by Vendetti merely charges a pre-assigned rate to
　　　　　calls placed within a particular zone.

2011 Brief, page 12, line 31 through page 13, line 2.

42.　　　The Examiner respectfully disagrees. Vendetti expressly discloses "… the cellular

service provider may wish to give a user a discount for calls made within the zone Z_1 …."

Vendetti, 5:38-40. As would be apparent to one of ordinary skill in the art, Vendetti's disclosed

"giv[ing] a user a discount" is equivalent to adjusting a price lower. Moreover, the disclosed

discount is based on the user's contract with the provider and the location of the user's phone

within zone Z_1. Vendetti, 5:20-44. Therefore, Vendetti meets the claimed "adjust the price

lower for selling the product to a person associated with the user identifier based at least in part

on the location data."

43.　　　Additionally, Appellants argue "The pricing structure is based on the zone used to

transmit a call, not a location of a mobile device." 2011 Brief, page 13, lines 2-4. The Examiner

respectfully disagrees. The price charged is based on the location of the mobile unit 62. See,

e.g., Vendetti, 5:20-44 and 6:20-39.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related

Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/JACOB C. COPPOLA/
Examiner, Art Unit 3621
09 January 2012

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